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10/729,999

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M. Alain Cadic

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EXAMINER

PARA, ANNETTE H

ART UNIT

PAPER NUMBER

1661

DATE MAILED: 06/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--|--|
| Office Action Summary | Application No. 10/729,999 | Applicant(s) CADIC, M. ALAIN | |
| | Examiner Annette H. Para | Art Unit 1661 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) _____ is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Applicant's remarks filed February 23, 2006 are acknowledged and entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in the prior Office action.

Claim 1 remains rejected under 35 USC 102(b) for reasons stated in the previous Office action dated November 23, 2005.

Applicant's arguments filed February 23, 2006 have been fully considered but they are not persuasive.

Applicant argues that there has been a misapplication of the statute under 35 U.S.C. §102(b) because one skilled in the art could not reproduce the instant cultivar from a publication, more than one year prior to the effective filing date of the instant application (p. 2 of reply).

Examiner agrees that no one can reproduce any plant from a publication; however, in this instant application the basis of the 102(b) rejection is the published document coupled with the foreign sale of the instant plant and the reproducibility of the instant plant more than one year prior to the effective filing date of this application. In *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004), the Court states the following on page 1039:

Plant Breeder's Rights applications published more than one year before effective filing dates of applications for plant patents are proper anticipatory references that may bar patentability of claimed plants under 35 U.S.C. § 102(b), even though PBR applications disclose claimed plant varieties but do not, by themselves, enable skilled artisan to practice claimed inventions or reproduce claimed plants, since public may have had access to claimed inventions through foreign sales of plants, from which claimed plants may be reproduced, and since secondary reference may be used to show that primary Section 102(b) reference was in fact enabled; although foreign sales are not prior art, precise issue is whether publication of PBR applications placed claimed inventions in possession of public before critical date, and foreign sales of claimed plants may be within knowledge of skilled artisan and may be considered to provide public with access to applicant's inventions.

The instant cultivar was described in the published Plant Breeder's Right (PBR) applications along with in the 1999 four-page leaflet entitled "Sapho Infos"(Exhibit C of parent application number 09/791,738) more than one year prior to the effective filing date of the instant application and the applicant's admission that the instant cultivar was first publicly available in France July 1999 (page 4 of reply dated August 29, 2002), more than one year prior to the effective filing date of the instant application. With regard to the reproducibility of the instant cultivar, a person skilled

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in the art would have the knowledge of reproducing the instant cultivar, given the notoriety of various methods of asexual propagation of caryopteris plant as shown by the Royal Horticultural Dictionary reference (Vol. 1, page 528).

Applicant argues that only a limited amount of the instant plant was available to limited area in the world with limited publicity, and that one skilled in the art would have no reasonable expectation to reproduce the instant cultivar (page 2 of reply).

This argument is not found persuasive because of applicant's admission that the instant cultivar was available to the public as early as July 1999 (page 4 of reply dated August 29, 2002), more than one year prior to the effective filing date of the instant application. Moreover, the instant cultivar was described in the 1999 four-page leaflet entitled "Sapho Infos" and the French Plant Breeder's Right Application number 16201 published on May 20, 1998, more than one year prior to the effective filing date of the instant application. In *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004), the Court cites a quotation from *In re Bayer* (568 F.2d 1357, 1361 [196 USPQ 670] (CCPA 1978)) on page 1043, "('[A] printed document may qualify as a 'publication' under 35 U.S.C. § 102(b)... so long as accessibility is sufficient to raise a presumption that the public concerned with the art would know of the invention.' (quotation omitted))." As in this case, a person skilled in the art had knowledge of foreign sale and the catalogs were publicly available, more than one-year prior. The four-page leaflets and the Jeunes Plants Tarif general from Andre Brian saison 1999/2000 were distributed to professionals within the caryopteris industry in France (page 6 of the reply). These professionals of the caryopteris industry would not have any problems asexually reproducing the instant cultivar.

Applicant argues that *In re LeGrice* is the controlling authority and must be followed by the examiners (page 3 of reply).

This argument has been fully considered, however, is not persuasive because *In re LeGrice*, the applicant never admitted the sale of the rose plants, and this issue was not considered in *LeGrice*. In *Elsner*, the Court agreed with the Office "there was no mention of sales in the *LeGrice* opinion" (page 1043). However in this situation, the applicant admitted that the claimed plant was in the public domain, more than one year prior to the effective filing date of this

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instant application, therefore, one skilled in the art could have possession of the claimed plant and could have asexually reproduced the instant cultivar.

Applicant argues that public use and availability in a foreign country, more than one year before the filing date is not an impediment to U.S. Patent protection (pages 3-4 of reply).

This argument has been fully considered, however, is not persuasive because as stated above the basis of this rejection is the published document combined with the foreign sale of the instant plant and the reproducibility of the plant. In *Elsner*, the Court states the following "Because the published applications, combined with the foreign sales of the plants, placed the claimed inventions in the possession of the public, we therefore hold that they are proper § 102(b) anticipatory references that may bar patentability."

Applicant argues that the *LeGrice* decision by Judge Smith with regard to when a printed publication can serve as a statutory bar had been properly applied and had been followed by the Patent Office for decades (page 4 of the reply).

This argument has been fully considered, however, is not persuasive because in *LeGrice* the appellant never admitted the sale of the rose plants and this was not an issue before the Court.

Applicant argues that the 102(b) rejection in *Ex parte Thomson* had been misapplied because that case involved a utility application (page 4 of reply).

This argument has been fully considered, however, is not persuasive because the standards in utility and plant patents are the same. 35 U.S.C. 161 and 37 C.F.R. 1.161 both state that patents for inventions shall apply to patents for plants, except as otherwise provided.

Applicant then argues that both *Thomson* and *LeGrice* cases had public use and availability of the plant material outside of the U.S., more than one year prior to the U.S. filing dates (pages 4-5 of the reply).

This argument has been fully considered, however, is not persuasive because in *Thomson*, the appellant admitted the availability of Siokra seeds. In *LeGrice*, there was no indication of the commercial availability.

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Applicant further argues that there is no way that a person skilled in the art could reproduce the claimed plant from a published document (page 5 of reply).

Examiner agrees that no one could reproduce any plant from a printed document. As stated above the basis for this rejection is the published PBR documents, catalogs and availability of the claimed plant, which enable the publications.

Applicant argues that the Court in *In re Elsner* had no authority under the U.S. Constitution to seek a change in the content of 35 U.S.C. § 161 (pages 5-6 of the reply).

This argument has been fully considered, however, is not persuasive because the Court in *Elsner* was conveying that there is a distinction between a utility and plant patent with regard to possession of the plant by publication and sale anywhere in the world would enable a person skilled in the art to practice asexual reproduction of the plant. The distinction for a plant patent to be granted is that it must be "[w]hoever invents or discovers and asexually reproduce any distinct and new variety of plant..." 35 U.S.C. § 161. A utility patent does not have that distinction. The court in *Elsner* states the following on page 1041:

In the case of plant patents, the touchstone of the statutory subject matter is asexual reproduction of a unique biological organism. When a publication identifies the plant that is invented or discovered and a foreign sale occurs that puts one of ordinary skill in the art in possession of the plant itself, which, based on the level of ordinary skill in the art, permits asexual reproduction without undue experimentation, that combination of facts and events so directly conveys the essential knowledge of the invention that the sale combines with the publication to erect a statutory bar.

Therefore, a publication is enabled by the foreign sale of the plant that places a skilled artisan in possession of the plant and then asexually reproduce the plant would constitute a bar under § 102(b).

For the reasons outlined above and in the previous Office action, the rejection is deemed proper and is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H Para whose telephone number is (571) 272-0982. The examiner can normally be reached Monday through Thursday from 5:30 a.m. to 4:00 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where the application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about PAIR system, see <http://pair-direct.uspto.gov> . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**KENT BELL
PRIMARY EXAMINER**

